

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 09/932,070 Conf. No.: 5575
Inventor: Vincentius Paulus Buil
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Examiner: Wassum, Luke S.
Docket No.: NL000434 (PHB-10-6199)
Customer No.: 24737

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

October 8, 2007

REPLY BRIEF

Dear Sir:

In response to the Examiner's Answer mailed August 6, 2007, please reconsider the above-identified application in view of the following comments:

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

Rejection of claims 18 and 20 under 35 U.S.C. 112, first paragraph

Referencing claims 17 and 19, the Examiner's Answer emphasizes that the result of a skip operation will be different depending on the mode of operation of the skip means. The Examiner's Answer also attempts to draw a distinction between the *mechanism* by which the modes are selected and the *modes* themselves. It is submitted that the subject claims are amply supported by the specification and that these purported distinctions are misplaced.

Claim 18 includes:

- a user-operable skip means for controlling the random selection means to
 - abort the presentation of the currently selected unit; and
 - skip to a randomly selected alternative unit whose attribute value meets [certain] criterionin dependence of a mode of operation of the skip means.
- The mode of operation of said skip means is selected from the group consisting of frequency of skip means operation and duration of skip means operation.

The Examiner's Answer reproduces only the second paragraph of page 3 of the present application. The first and second paragraphs of page 3 are reproduced in their entireties below:

An embodiment of the system according to the invention is characterized by the system further comprising user-operable *skip means for controlling the random selection means to abort the presentation of the currently selected unit and to skip to a randomly selected alternative unit whose attribute value meets said criterion*. In this way it is achieved that if the user does not like a currently selected unit, he can easily stop its presentation and cause the random selection means to choose an alternative unit which also meets the current criteria. The user is thus able to quickly explore the collection, without explicitly selecting units for presentation. He need only *operate the skip means, which may take the form of a simple button, to select the alternative unit*.

An embodiment of the system according to the invention is characterized by said skip means being capable of removing at least one criterion in dependence on a mode of operation of said skip means. This provides an extremely quick and intuitive way of requesting the presentation of another information unit. A *'default' mode of operation of the skip means, e.g. simply pressing a skip button, invokes the normal function of the skip means, as described above. A slightly deviant mode of operation, however, will remove one or more criteria before invoking the normal skip function and thus widen the search space of the random selection means.* Preferably, criteria for dependent attributes are removed before criteria for attributes they depend on. For example, a criterion for the 'style' attribute would be removed before a criterion for the 'genre' attribute, which gradually widens the search space. Examples of such *deviant operations are iterated or prolonged operation, e.g. pressing the skip button a second time shortly after the first time to remove a criterion for an 'artist' attribute, pressing three times to remove criteria for both the 'artist' and the 'style' attribute, pressing for one second to remove criteria for the 'artist', the 'style' and 'genre' attributes, etc.*

(emphasis added).

Thus, according to one example described in the specification, the skip means may include a button. Simply pressing the skip button invokes the button's normal function, e.g., controlling the random selection means to abort the presentation of the currently selected unit and skip to a randomly selected alternative unit. The specification also states that the function performed by the skip button may depend on its manner or mode of operation:

- A first deviant mode of operation of the skip means, e.g. pressing the skip button a second time shortly after the first time, removes certain criteria before invoking the normal or default skip function. Thus, the skip button controls the random selection means to abort the presentation of the currently selected unit and skip to a randomly selected alternative unit in dependence on the frequency of the skip button operation.
- A second deviant mode of operation of the skip means, e.g. pressing the skip button for one second, removes certain criteria before invoking the normal or default skip function. Thus, the skip button controls the random selection means to abort the presentation of the currently selected unit and skip to a randomly selected alternative unit in dependence on the duration of the skip button operation.

Consequently, it is evident that claim 18 is amply supported by the present application as filed.

The foregoing applies, *mutatis mutandis*, to claim 20.

The Office indicates that “The specification discloses that for a skip operation, there exists a ‘default’ mode of operation (involving merely skipping the currently-playing song and randomly selecting another song)...” Applicants note however that the specification says “A ‘default’ mode of operation of the skip means, e.g. simply pressing a skip button, invokes the normal function of the skip means, as described above.” Hence, the Office’s characterization of the specification *leaves out* “e.g. simply pressing a skip button”.

The Office further states that “according to the disclosure, the claimed ‘frequency of skip means’ and ‘duration of skip means’ are the *mechanism by which one of the modes are selected*, and do not constitute modes of operations themselves.” Applicants cannot find any mention of “mechanism” in the specification. It is not clear why the Office is attempting to *rewrite* the specification. Applicants note however that the specification explicitly states “A *slightly deviant mode of operation*, however, will remove one or more criteria a before invoking the normal skip function and thus widen the search space of the random selection means...Examples of such *deviant operations* are iterated or prolonged operation...” Thus, it is clear that the specification discloses deviant “modes of operation” that are “iterated” (frequency) or “prolonged” (duration). The explicit disclosure of a *slightly deviant mode of operation*, examples of which include *iterated or prolonged operation*, supports frequency of skip means’ mode of operation or a ‘duration of skip means’ mode of operation.

It is noted that the meaning of the claim terms should not be limited in any way by this analysis, which focuses on support from the claims under 35 U.S.C. 112, first paragraph. That is, claim support and claim construction are two entirely different issues and should not be confused.

Prior Art Rejection under 35 USC 102(b) and 103(a)

First, it is submitted that the Examiner's Answer conflates two very different issues. At pages 11-21, the Examiner's Answer attempts to frame the issue in terms of the purportedly minimal differences between the present claim and a claim previously considered by the Board. Such is not the standard for anticipation.

The appropriate legal standard is clear – each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference.¹ Thus, present claims must be evaluated, not in view of a prior version of the claims, but in view of the Cluts reference.

Beginning at page 21, the Examiner's Answer asserts that Cluts discloses the random selection means of claim 1. The Answer acknowledges that Cluts presents a *list* of songs to the user and reproduces Figure 10 in support. The Answer further asserts that Figure 10 alone anticipates the recited means. As support, the Answer points to the Board's analysis of a *previous version* of the claim.² Moreover, at page 25 of the Answer, it is asserted that "it is the initial presentation of the list of songs to the user as illustrated in step 1025 of drawing Figure 10 that anticipates the appellants' 'presentation for playback' limitation."

These assertions are respectfully traversed. First, the issue at hand is whether the *present* claim is anticipated by Cluts, not the Board's view of a *previous* claim. Second, the Examiner's Answer ignores the clear language of claim 1.

Claim 1 recites, in part, a system comprising

- presentation means for presenting . . . information units *via audio or video playback*;
- random selection means *for automatically and randomly selecting and presenting*

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² Note that the various references to the Board's previous decision refer to the previous version of the claim and not the claim at issue. See, e.g., Examiner's Answer Page 23 bridging 24, page 25 (bottom).

for playback [an information] unit;

- the *selection and presentation for playback being made without interaction by a user.*

At most, and as acknowledged by the Examiner's Answer, Cluts step 1025 merely presents a *list of songs for acceptance by the user*. If accepted, the songs are *added to a playlist* at step 1035, and the process terminates. As is evident and also more fully set forth in Applicant's Appeal Brief and other papers submitted in this case, the aspects of Cluts replied upon in the Answer do not anticipate the present claim.

Moreover, the Examiner's Answer suggests that the clear language of the claim should be disregarded, asserting that the presentation *for playback* performed by the random selection is a mere intended use. This contention is also traversed. As will be appreciated, the relevant claim language describes the function performed by the recited means, not an intended use. Such a conclusion is further supported by the claim language when read in its entirety, which explicitly requires a presentation means for presenting information units via audio or video playback, and that the selection and presentation for playback be made without interaction by the user.

The Examiner's Answer presents similar arguments in regard to various other claims (*e.g.*, claim 14 at page 30, claim 15 at page 36, claims 1 and 14 at page 37-39). The remarks of the previous paragraph apply, *mutatis mutandis*.

In addition, at pages 37-38, the Examiner's Answer attempts to draw a distinction between the presentation of songs – which the Answer interprets to mean the display of a list of songs – and playback of songs. Regardless of the interpretation of the “presentation of songs,” claim 1 requires a means for selecting and presenting a song (or other information unit) *for playback* and a presentation means for presenting songs (or other information units) *via audio or video playback*. The interpretation proposed in the Examiner's Answer thus disregards the clear language of the present claim.

Regarding the arguments presented at the bottom of page 25 of the Examiner's

Answer, it is again pointed out that the Board's analysis refers to a previous version of the claim.

Regarding the arguments presented at page 30 of the Examiner's Answer and claim 14, it is pointed out that the claim requires, among other things:

random selection means for randomly selecting . . . and sending said at least one information unit to a presentation means for playing said at least one information unit.

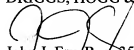
Again, Cluts merely teaches that a list of songs is presented to the user for acceptance, and fails to disclose or suggest a random selection means that performs the function required by claim 14.

As to those matters not specifically addressed in this paper, the Board's attention is respectfully directed to Applicant's argumentation already of record in this case, and particularly to the Appeal Brief and the Amendment dated October 17, 2006.

Conclusion

In view of the foregoing, it is submitted that the pending claims distinguish patentably and non-obviously over the prior art of record. Reversal of the outstanding rejections is respectfully requested.

Respectfully submitted,
DRIGGS, HOGG & FRY CO., L.P.A.



John J. Fry, Reg. 35,873
Driggs, Hogg & Fry Co., L.P.A.
38500 Chardon Road
Willoughby Hills, Ohio 44094
Phone: 1.440.391.5100
Fax: 1.440.391.5101

Direct all correspondence to:

Yan Glickberg, Registration No. 51,742
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9618
Fax: (914) 332-0615